



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,353	11/14/2003	Benjamin H. Malka	05793.3114	1450
22852	7590	11/10/2009	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			COLBERT, ELLA	
ART UNIT	PAPER NUMBER			
	3696			
MAIL DATE	DELIVERY MODE			
11/10/2009	PAPER			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/712,353	Applicant(s) MALKA ET AL.
	Examiner Ella Colbert	Art Unit 3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 May 2009.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10, 12-16, 32-41, 43-47, 63-72 and 74-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-10, 12-16, 32-41, 43-47, 63-72, and 74-78 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-10, 12-16, 32-41, 43-47, 63-72, and 74-78 are pending. Claims 1, 3-6, 8, 10, 12, 15, 16, 32, 35-37, 39, 41, 43, 47, 63, 66-68, 70, 72, 74, and 77-78 have been amended in this communication filed 05/22/09 entered as RCE and Request for Extension of Time.
2. The 35 USC 112, Second Paragraph Rejection for Claims 1-10 and 12-16 in the Office Action mailed 1/22/09 is hereby withdraw in view of Applicants' amendments to the claims. However, there are still remaining 35 USC 112, Second Paragraph Rejections as set forth here below.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/22/09 has been entered.

Claim Objections

Claim 63 is objected to because of the following informalities: Claim 63 contains a misspelled word "polarity" which should be "plurality". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3696

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 32, and 63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "determining, by the processor, a first portion of the financial investment fund to invest in a plurality of certificates of deposit issued by the financial institution, wherein the plurality of certificates of deposit mature at varying dates with a degree of laddering based on anticipated need for liquidity within the aggregated fund, ... to perform a function of the financial institution wherein function requires the ...; which is unclear and indefinite as written. The metes and bounds of this claim cannot be determined. Further, it is unclear and indefinite as to what Applicants' mean by "a function of the financial institution". A function of the financial institution to provide cash is varied and indefinite. Do Applicants' mean to cash a check or to pay dividends from a certificate of deposit to a customer or investor?

Suggestion: "determining, by the processor, a first portion of the financial investment fund to invest in a plurality of certificates of deposit issued by the financial institution, wherein the plurality of certificates of deposit mature at varying dates with a degree of laddering based on anticipated need for liquidity within the aggregated fund;

Using by the financial institution the first portion ...:

performing the function requires the financial institution to provide cash to the plurality of investors;". Claims 32 and 63 have a similar issue.

Claim 32 further recites " a component for receiving ...;". It is vague, varied, and indefinite as to what "component" is doing the received". Do Applicants' mean any component that can perform a receiving function?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,297,026) Hoffman in view of (US 5,291,398) hagan.

Claim 1. Hoffman discloses, A method, performed by a processor, associated with a financial institution, for funding the financial institution through a financial investment fund, the method comprising:

receiving, by the processor (Fig. 3(62), a plurality of individual funds corresponding to a plurality of investors respectively (col. 2, lines 32-47 and col. 3, lines 1-25); aggregating, by the processor (Fig. 3(62), the plurality of individual funds into an aggregated fund for investing into the financial investment fund (col. 2, lines 57-68). Hoffman failed to disclose, determining, by the processor, a first portion of the financial investment fund to invest in a plurality of certificates of deposit issued by the financial institution, wherein the plurality of certificates of deposit mature at varying maturity dates with a degree of laddering based on anticipated need for liquidity within the aggregated fund, and wherein the financial institution uses the first portion of the financial investment fund to perform a function of the financial institution, wherein the function requires the financial institution to provide cash; and determining, by the processor, based on the amount of the first portion invested in the plurality of certificates of deposit, a second portion of the

financial investment fund for investing in a transaction account, wherein the transaction account is used to fund a withdrawal from the financial investment fund by any investor among the plurality of investors. Hagan discloses, determining, by the processor, a first portion of the financial investment fund to invest in a plurality of certificates of deposit issued by the financial institution, wherein the plurality of certificates of deposit mature at varying maturity dates with a degree of laddering based on anticipated need for liquidity within the aggregated fund, and wherein the financial institution uses the first portion of the financial investment fund to perform a function of the financial institution, wherein the function requires the financial institution to provide cash Col. 1, line 42-col. 2, line 64 and col. 3, lines 41-55); and determining, by the processor, based on the amount of the first portion invested in the plurality of certificates of deposit, a second portion of the financial investment fund for investing in a transaction account, wherein the transaction account is used to fund a withdrawal from the financial investment fund by any investor among the plurality of investors (col. 6, line 15-col. 8, line 30). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Hagan in Hoffman because such an incorporation would allow Hoffman to have the capability to periodically monitor accounts by focusing on the additions of interest to all accounts and regarding certificates of deposit and the due dates of those CDs such that when a particular CD becomes due the principal is returned to the investment company.

Claim 32. Hoffman discloses, A system, including a processor associated with a financial institution, for funding the financial institution through a financial investment

fund, the system comprising: a component for receiving a plurality of individual funds corresponding to a plurality of investors respectively (col. 2, lines 32-47 and col. 3, lines 1-25); a component for aggregating the plurality of individual funds into an aggregated fund for investing into the financial investment fund, wherein the financial investment fund includes a plurality of certificates of deposits and a transaction account (col. 2, lines 57-68). This independent claim is rejected for the similar rationale as given above of claim 1.

Claim 63. Hoffman discloses, A computer-readable medium on which is stored a set of instructions for funding a financial institution through a financial investment fund, which when executed perform stages comprising: receiving a plurality of individual funds corresponding to a plurality of investors respectively (col. 2, lines 32-47 and col. 3, lines 1-25); and aggregating the plurality of individual funds into an aggregated fund for investing into the financial investment fund, wherein the financial investment fund includes a plurality, of certificates of deposits and a transaction account (col. 2, lines 57-68). This independent claim is rejected for the similar rationale as given above for claims 1 and 32.

Claims 2-10, 12-14, 33-41, 43-45, 64-72, and 74-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,297,026) Hoffman and (US 5,291,398) Hagan in view of (US 4,985,833) Oncken .

Claims 2, 33, and 64. Hoffman failed to disclose, wherein the second portion is used when an investor requests liquidation of funds invested in at least one certificate of

Art Unit: 3696

deposit at a time before the certificate of deposit matures. Oncken discloses, wherein the second portion is used when an investor requests liquidation of funds invested in at least one certificate of deposit at a time before the certificate of deposit matures (col. 2, lines 10-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Oncken in Hoffman because such an incorporation would allow Hoffman to have the interest rate fixed for the term of the certificate of deposit and to have penalties assessed for early withdrawal.

Claims 3, 34, and 65. Hoffman discloses, further comprising paying, by the processor (Fig. 362), a return to the plurality investors from the financial investment fund (col. 4, lines 30-53).

Claims 4, 35, 66. Hoffman discloses, wherein one of the at least one financial institution manages the financial investment fund (col. 5, line 55-col. 6, line 15).

Claims 5, 36, and 67. Hoffman discloses, wherein the plurality of certificates of deposit have at least one of varying return rates and varying maturity dates (col. 3, lines 1-12).

Claims 6, 37, and 68. Hoffman discloses, wherein the plurality of certificates of deposit include at least one of jumbo certificates of deposit, promissory notes, time deposits, and bonds (col. 2, lines 57-68).

Claims 7, 38, and 69. Hoffman discloses, wherein the function of the financial institution comprises a credit card operation (col. 2, lines 32-47).

Claims 8, 39, and 70. Hoffman discloses, The method of claim 7, wherein the financial institution uses the first portion to pay merchants for goods or services provided to users

Art Unit: 3696

of credit cards provided by the financial institution (col. 5, line 33-col. 6, line 15).

Claims 9, 40, and 47. Hoffman and Hagan failed to disclose, wherein at least a portion of the plurality of individual funds is insured by the United States federal government.

Oncken discloses, wherein at least a portion of the plurality of individual funds is insured by the United States federal government (col. 1, lines 12-56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Oncken in Hoffman because such an incorporation would allow Hoffman to have funds in accounts insured to \$100,000 or more if the amount over \$100,000 is placed in other accounts such as money market, certificates of deposit (cd's) or savings accounts or mutual funds or 401K's or bonds.

Claims 10, 41, and 72. Hoffman, Hagan, and Oncken failed to disclose, wherein the financial investment fund is configured to allow at least one of the plurality of investors to withdraw from the financial investment fund at any time regardless of maturity dates of any of the plurality of certificates of deposit. It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow at least one of the plurality of investors to withdraw from the financial investment fund at any time regardless of maturity dates of any of the plurality of certificates of deposit because deposits are of a temporary nature and will be relocated based entirely on rate.

Claims 12, 43, and 74. Hoffman discloses, wherein the amount in the transaction account is established to cover no more than an expected amount of the withdrawals from the financial investment fund over a given amount of time (col.2, lines 26-31).

Claims 13, 44, and 75. Hoffman discloses, wherein a yield received by an enterprise

managing the financial investment fund on the plurality of financial instruments is greater than a yield received by the enterprise managing the financial investment fund on funds in the transaction account (col. 5, line 32-col. 6, line 26).

Claims 14, 45, and 76. Hoffman, Hagan, and Oncken failed to disclose, wherein the financial investment fund is used in conjunction with at least one of an individual retirement account and a 401K account. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the financial investment fund used in conjunction with an individual retirement account and a 401K account because this would allow for another means of investment for an individual who is planning for retirement.

Claims 15, 16, 46, 47, 77, and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,297,026) Hoffman, (US 5, 291,398) Hagan in view of (US 4,985,833) Oncken and further in view of (US 5,987,436) Halbrook.

Claims 15, 46, and 77. Hoffman, Hagan, and Oncken failed to disclose, further comprising providing access to the financial investment fund comprises communicating over a network. Halbrook discloses, wherein providing the financial investment fund via communicating over a network by the processor (col. 3, lines 53-62). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Halbrook in Hoffman and Oncken because such an incorporation would allow Hoffman and Oncken to make deposit and to move

investments around in different investments by using a network.

Claims 16, 47, and 78. Hoffman, Hagan and Oncken failed to disclose, wherein user devices on the network are located in at least one of a home, an office, a store, a retail center kiosk, an office of financial institution, and an office of an enterprise managing the financial investment fund. Halbrook did not expressly disclose where his system is located in col. 3, lines 45-62. The method, system, and computer readable medium is performed in the same manner regardless of the location. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ 1031 (Fed. Cir. 1994).

.Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

DiCresce (US 5,991,744); Edelman (US 6,085,174); Bent et al. (US 7,509,286); Kosinski (2003/0028465); FACCIANI et al. (US 202/0013751); and Robinson et al. (US 2003/0204460).

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741.

The examiner can normally be reached on a Flexible Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Trammell James can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

November 8, 2009